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Supreme Court of the United States

October Term 1941

No. 323

MUNCIE GEAR WORKS, INC. and BRUNS &
COLLINS, INC.,

Petitioners,

vs.

OUTBOARD, MARINE & MANUFACTURING
COMPANY and JOHNSON BROTHERS
ENGINEERING CORPORATION,

Respondents.

BRIEF FOR PETITIONERS

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BRIEF FOR PETITIONERS.

This is an infringement suit on Johnson Patent No. 1,716,962, here on writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit.

Respondent, Johnson Brothers Engineering Corporation (an Indiana corporation), is the title owner of the patent, and respondent, Outboard, Marine & Manufacturing Company (a Delaware corporation), is the exclusive licensee thereunder.

The patent relates to a "water propulsion device", more popularly known as an outboard motor, demountably attached to a rowboat, or the like, to propel it by power.

Petitioner, Muncie Gear Works, Inc. (an Indiana corporation); is the manufacturer, and petitioner, Bruns & Collins, Inc. (an Illinois corporation), is a retail seller of the outboard motors charged to infringe.

Opinions of the Courts Below.

The opinion of the District Court, which found the patent to be invalid, is not reported, but will be found in the Record beginning at page 242.¹

The decision of the Court of Appeals, which reversed the District Court and found validity for the patent, is reported in 119 Fed. (2d) 404 (see also R. 616).²

Jurisdiction.

The date of the judgment to be reviewed is January 29, 1941; rehearing denied May 16, 1941.

The writ of certiorari was granted by this Court on October 13, 1941.

The jurisdiction of this Court is invoked under Judicial Code Section 240(a), 28 U. S. C. A. 347, as amended by the Act of February 13, 1935.

Cases believed to sustain the jurisdiction are:

Scriber-Schroth v. Cleveland Trust Co., 305 U. S. 47;

Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U. S. 464;

Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U. S. 477.

Statement of the Case.

1. Respondents instituted the suit against petitioners on claims 11, 12, 13 and 14 of the Johnson patent in the

¹ The portion of the opinion dealing with the Johnson patent here involved will be found on pages 242-244 inclusive.

² The portion of the opinion dealing with the Johnson patent here involved will be found on pages 620-622 inclusive.

United States District Court for the Northern District of Illinois, Eastern Division.³

2. The District Court found the patent to be invalid (R. 242-244).

3. The Circuit Court of Appeals reversed, and held the patent valid and infringed (R. 620-622).

4. Petitioners here seek a reversal of the judgment of the Circuit Court of Appeals.

Specification of the Assigned Errors to Be Urged.

1. The Circuit Court of Appeals erred in sustaining the Johnson patent as valid.

2. The Circuit Court of Appeals erred in reversing the judgment of the District Court.

3. The Circuit Court of Appeals erred in failing to invalidate the Johnson patent because of the illegal amendment thereof to claim subject matter injected into the application, by amendment, more than two years and seven months after the application was filed, and more than two years after said subject matter had been commercially adopted.

4. The Circuit Court of Appeals erred in failing to invalidate claims 11, 12, 13, and 14 of the Johnson patent be-

³ The suit also included two additional Johnson patents (R. 12), and the litigation included a companion suit involving five additional patents (R. 2). By stipulation, the two cases were consolidated and tried as one on a single record as to seven of the total of eight patents involved, one patent having been withdrawn prior to trial. The Courts below disposed of six of the seven patents adversely to the patents, so that the present review is concerned only with the single Johnson patent above identified.

cause of anticipation by and want of invention over the prior art; and because of the unpatentably aggregational character thereof.

Summary and Order of Argument.

Point 1. Claims 11, 12, 13 and 14 of the Johnson patent are invalid because of the illegal insertion thereof (and of the subject matter to which they are directed) into the application for patent more than two years and seven months after the application was filed, and more than two years after such subject matter had been commercially adopted.

Point 2. The four claims of the Johnson patent are invalid because they merely catalog unpatentable aggregations.

Point 3. The Johnson patent is invalid because of anticipation by or want of invention over the prior art.

Argument.

Before taking up specific consideration of the points of argument, it is believed to be desirable to crystalize the alleged invention of the Johnson patent. The most effective way to do this is to become generally familiar with what preceded it, so that there will be brought into bold relief the respect in which the alleged invention distinguishes from what had gone before.

As has already been stated, the Johnson patent relates to an outboard motor demountably attached to a rowboat, or the like, to propel it by power. This art is an old one, and, since its inception, an outboard motor has usually consisted of a gasoline engine connected to a shaft which it rotates, an encased propeller shaft (usually at right angles to the engine shaft, and geared thereto), a propeller on

the propeller shaft, a manually rotatable flywheel on the engine shaft, a steering handle for moving the entire assembly about the axis of the engine shaft for steering purposes, and an adjustable bracket for supporting the entire assembly and at the same time permitting a demountable attachment to the boat to be propelled. In addition to the foregoing general make-up of an outboard motor, there has necessarily been included the usual incidents to a gasoline engine, such as a fuel tank, a carburetor, a magneto or other sparking device for ignition purposes, a water cooling jacket for the engine, including the necessary pipe lines or conduits for a cooling water system, etc.

A casual examination of but a few instances of the prior art of record will conclusively establish the accuracy of the foregoing statement (R. 394, 482, 591, 603).

Early in the development of the art "cavitation" was recognized as an effect that it was desirable to overcome or eliminate. The term "cavitation" is used to describe the drawing of air, by the action of the propeller, from above the surface of the water to the propeller itself.⁴ Therefore, an "anti-cavitation" plate consists merely of a flat plate horizontally positioned above the propeller, and between the propeller and the surface of the water, to act as a baffle and prevent the action of the propeller from drawing air thereto from the surface of the water,

Since the realization of the undesirable phenomenon of cavitation, and its cure by the use of an anti-cavitation plate, it has been customary to equip outboard motors with such plates, regardless of the particular details of the motor construction. Two instances of prior art recognition of the

⁴ The motor functions most efficiently when its propeller is at all times surrounded by water. If air is drawn to the propeller blades it results in reducing the propulsive effect of the propeller as well as the resistance to the propeller rotation afforded by the water, and causes "racing" of the motor.

use of anti-cavitation plates for outboard motors are believed to be sufficient to establish this point (R. 418, where the anti-cavitation plate is identified by the reference numeral 12, and R. 482, where the anti-cavitation plate is identified by the reference numeral 47).

Finally, in view of the fact that all of the outboard motors project the propeller (and its casing) into the water, and, when in operation, the propeller casing moves through the water, it was early realized that it was desirable to shape the propeller casing so as to reduce or minimize its resistance to the water streaming past. Therefore, for many years prior to Johnson it was customary in the art to form the propeller shaft casing so as to present a rounded, smooth or unbroken surface (viz., to "streamline" it), and to locate within the casing the necessary water conduit for supplying the cooling water to the water jacket of the engine (R. 502, 526, 591).⁵

Therefore, with an understanding of what was known to the art prior to Johnson, we will next take up the application for the Johnson patent, as filed, to ascertain, specifically, what the applicant described and claimed as his invention differentiating from that art.

The Johnson application as originally filed.

The single sheet of drawing filed with the Johnson application on August 25, 1926, was not changed during the prosecution of the application, with the result that it is the same as the drawing of the issued patent. In consequence,

⁵ Other instances of the prior art illustrating a streamlining of the propeller casing will be found at R. 360, 376, 394, 494, 532; and other instances of the prior art showing the positioning of the water line or conduit within the propeller casing will be found at R. 388, 422, 518, 603.

either may be referred to (Appendix, 13 or R. 340).⁶ The drawing merely shows, conventionally, an outboard motor assembly consisting of the usual engine 1, steering handle 9, a propeller 10, connected to the engine by the usual geared horizontal and vertical shafts, the propeller shaft being enclosed by casing 17, supporting the conventional anti-cavitation plate 20.

The only thing shown by the drawing which was not standard or conventional in the art was *the extension of the casing 17, in the form of an arch 16, 18, over the top and to the rear of the propeller blade 11, with a curved plate 19 extending rearwardly therefrom* (see the elevational views of Figs. 1 and 2, and the plan view of Fig. 3). The asserted function of this plate 19 (termed a "deflecting" plate) is to counteract the pivotal movement of the motor induced by the rotation of the propeller, and thereby relieve the strain on the operator's hand in steering. This arching portion of the casing over and in back of the propeller, with the curved deflection plate formed as a part thereof, is the *only* feature which was advanced as differentiating Johnson's disclosure from the outboard motors of the prior art. Indeed, *it was this feature alone that was described and claimed as Johnson's invention, as will now be shown.*

Referring to the specification, it will first be seen that the first three paragraphs thereof (Appendix, 5, 6), which recite the "objects" of the invention, are *all* directed to the deflection plate and its support arched over and to the rear of the propeller.

⁶ The file history of the Johnson application in the Patent Office is in evidence as Defendants' Exhibit I. Because of the fact that it was treated as a physical exhibit on the appeal by respondents to the Court of Appeals, it has been reproduced for the purposes of this review as an appendix to petitioners' brief. Our references thereto will be to the printed page numbering in the appendix.

It will next be seen that each of the eleven claims filed with the application (defining the *invention* for which Johnson solicited a patent) was specifically directed and limited to the provision of this deflection plate (or the arched support therefor), claims 9, 10 and 11 claiming this feature in combination with an anti-cavitation plate (Appendix, 10, 11).

All of the claims of the application were rejected on December 15, 1926 (Appendix, 14), and in response thereto an amendment was filed on December 13, 1927, retaining all of the prior claims in the application, and adding two *additional* claims, *each of which, likewise, was specifically directed and limited to the feature of the deflection plate* (Appendix, 17).

On January 19, 1928, three additional claims were presented (Appendix, 21), *all of which, likewise, were specifically directed and limited to the feature of the deflecting plate.*

Normal prosecution of the application continued until March 30, 1929, at which date *the sole invention of Johnson shown, described or claimed in his application, consisted of the deflection plate and its arched support over and to the rear of the propeller.* We pause at this point to state, in passing, that petitioners' outboard motors charged to infringe the Johnson patent do *not* employ a deflection plate or an arched support—*nor do respondents claim that they do.*

On March 30, 1929—*more than two years and seven months after the application was filed*—the Johnson application was radically changed. *An entirely new statement of invention was injected into the specification.* It is believed that the easiest way by which this new subject matter can be identified is by reference to the patent as issued (R. 341), in which the matter *added* to the application is represented.

in the issued patent by (1) the entire paragraph from line 46 to and including line 74 (R. 341); and (2) the entire paragraph from line 58 to and including line 110 (R. 342). It will be seen therefrom that there was thus injected into the application as its *new* statement of invention, the provision of a propeller-carrying-casing with an anti-cavitation plate "arranged so as to directly overlie the path of travel of the propeller blades"; and in forming the exterior surface of the casing "relatively broad and smooth", or "smooth and unbroken", or with "stream-line surfaces" so as "to permit the housing to travel through the water with minimum resistance"; and water passages internal of the housing so that "water can be delivered to the water jacket of the motor".

Therefore, it will be seen that Johnson's invention, which he described in his application filed *August 25, 1926* as comprising solely a deflection plate at the rear of the propeller, or its support formed by an arched extension of the propeller shaft casing, was, on *March 30, 1929*, changed to include a smooth and unbroken propeller shaft housing supporting an anti-cavitation plate cast integrally therewith, and enclosing internal water passages for cooling the engine of the motor. Having thus injected this new subject matter into the application, the same amendment presented claims directed thereto, thus *for the first time* claiming an invention other than the deflection plate or its arched support. Four of these new claims, namely 28, 29, 30 and 31 (see Appendix, 42-44 inclusive) with slight amendment, thereafter issued as claims of the patent numbered 11, 12, 13 and 14, here involved.

We pause again to note (and the matter will be hereinafter more fully developed in connection with our first point of argument), that it has been established in the Record that outboard motors incorporating *the alleged invention defined*

by each of these four new claims had been in public use and on the commercial market for more than two years prior to this radical alteration of Johnson's statement and claim of invention.

Next let us take up detailed consideration of these four new claims which are in issue in this case.

**Claims 11, 12, 13, and 14 of the
Johnson patent as issued (R. 343-344).**

An analysis of claim 11 shows that it aggregationally combines ten usual elements of an outboard motor assembly. These are:

- (1) a stationary support carrying a bearing (common to most outboard motor structures, *e. g.* R. 591);
- (2) a drive shaft casing mounted to turn in said bearing (likewise common to most outboard motor structures, *e. g.* R. 591);
- (3) a motor mounted on the upper end of said drive shaft casing, with its drive shaft disposed within the drive shaft casing, and said shaft passing downwardly therethrough (likewise common to most outboard motor assemblies, *e. g.* R. 591);
- (4) a housing mounted on the lower portion of the drive shaft casing and turning therewith (likewise common to most outboard motor assemblies, *e. g.* R. 591);
- (5) said housing including a substantially horizontal barrel-like portion (likewise common to most outboard motor structures, *e. g.* R. 591);
- (6) a propeller shaft mounted within said barrel-like portion, and having a driving connection with the motor drive shaft (likewise common to most outboard motor assemblies, *e. g.* R. 591);

- (7) a propeller on said propeller shaft (likewise common to most outboard motor assemblies, *e. g.* R. 591);
- (8) said housing extending upwardly from said barrel-like portion and provided well below its top with an anti-cavitation plate extending rearwardly therefrom overlying the path of forward travel of the propeller blades (likewise common to most outboard motor assemblies which employ an anti-cavitation plate, *e. g.* R. 482, 418);
- (9) said housing having a substantially vertical internal passage leading to the water jacket of the engine (likewise common to many outboard motor assemblies which employ a water-cooled engine, *e. g.* R. 591); and
- (10) said passage opening at a point below normal water level (likewise common to and obviously a necessity in all outboard motor assemblies employing water cooling, *e. g.* R. 591).

It will be seen, therefore, that this claim merely aggregates a number of old and necessary elements of an outboard motor, as the District Court specifically found (R. 243-244; see also Findings of Fact 6 (d) and (e), R. 293; and Conclusions of Law 1 and 3, R. 296-297).

The only material difference between claim 12 and claim 11 is that claim 12 adds an additional element (between elements 8 and 9 above), as follows:

"said housing having *unbroken outer wall surfaces* at each side extending upwardly from said barrel-like portion to said plate and from said plate upwardly a substantial distance to the top of the housing".

(This, likewise, is common to all outboard motor assemblies employing anti-cavitation plates, where effort has been

made to minimize the water-resistance to that portion of the assembly which is projected into the water.)

An analysis of claim 13 shows that it, likewise, aggregationally combines four usual elements of an outboard motor assembly. These are:

- (1) a vertically extending turnable propeller shaft casing provided with an internal water passage opening below normal water level (common to many outboard motor assemblies which employ a water-cooled engine, *e. g.* R. 591);
- (2) a propeller mounted thereon (likewise common to all outboard motors, *e. g.* R. 591);
- (3) means for turning said casing for steering (likewise common to most outboard motor assemblies, *e. g.* R. 591);
- (4) said casing having an anti-cavitation plate *cast integral therewith* and located in a plane above the propeller (the only novel feature of this element is the *integral casting* of the propeller casing and the anti-cavitation plate—obviously a mere matter of design or choice).⁷

Claim 14 differs from claim 13 only in reciting that the casing is provided with "smooth and unbroken walls extending upwardly", and that the anti-cavitation plate is located "substantially midway" of the height of the casing. (The expedient of making the outer surface of the propeller shaft casing "smooth and unbroken", and of extending it "upwardly" to the approximate water level was well known in the art—indeed it was a most obvious expedient where

⁷ As to this the District Court quite properly stated (R. 243):

"I cannot see any invention in casting an anti-cavitation plate integrally with the housing".

reduction of water resistance was desired, for example, see R. 591. Similarly, the anti-cavitation plate was *always* positioned below the surface of the water, otherwise it would not serve its intended function, *e. g.* R. 418, 482.)

It will be seen from the foregoing analysis of the four claims that not one of them so much as mentions the deflecting plate or its arched support. In consequence, it is evident that all four of the claims of the patent here involved are for an invention radically different from that which Johnson described in his application as originally filed, and for which he ~~solicited~~ a patent.

The opinion of the Court of Appeals.

Notwithstanding the fact that all four of the claims of the Johnson patent merely define an aggregational combination of standard, necessary elements of a conventional outboard motor assembly, and, at most, refer to the propeller casing projected into the water as having "unbroken outer wall surfaces" (claim 12) or "smooth and unbroken walls" (claim 14); and despite the further fact that the file history of the Johnson patent discloses that the *only* invention for which a patent was originally solicited consisted of the *deflection* plate, and that an anti-cavitation plate was concededly old in the art,⁸ the Court of Appeals found validity for the patent on its assertion (R. 620):

" * * * *its object is to avoid what in this art is known as cavitation, the avoidance of which was desirable, if not necessary, in the construction and successful operation of high powered outboard motors*".

⁸ See the statement in the amendment of December 13, 1927 (Appendix, 19) that "* * * it is conceded that cavitation plates are old in the art * * *."

The Court thereupon proceeded to find (R. 621):

“cooperative relationship between the anti-cavitation plate and stream-lining of a portion of the outboard motor structure”

and on that finding—with respect to a feature which is not included in any of the four claims in suit—found validity for the patent.

POINT I.

Claims 11, 12, 13 and 14 of the Johnson patent are invalid because of the illegal insertion thereof (and of the subject matter to which they are directed) into the application for patent more than two years and seven months after the application was filed, and more than two years after such subject matter had been commercially adopted.

It has been shown by the foregoing review of the history of the Johnson application that the four claims of the Johnson patent, as well as the subject matter to which they are directed, were inserted into the application on *March 30, 1929*, more than two years and seven months after the application was filed on *August 25, 1926*. It has likewise been shown that these claims, and their subject matter, are radically different, in every respect, from what was described and claimed as Johnson's invention when he filed his application for patent.

In addition, it has been established by respondent's own evidence, given by officials of respondent Outboard, Marine & Manufacturing Company, that commercial adoption—public use—of the subject matter claimed by the four claims of the Johnson patent occurred more than two years prior

to the injection thereof, by amendment, into the Johnson application.

Thus, Finn T. Irgens, the Chief Engineer and Production Manager of respondent, Outboard, Marine and Manufacturing Company, testified as follows (R. 43):

"Q. How long has it been true that all of the larger sizes of outboard motors have been equipped with smooth walled lower unit housings, anti-cavitation plates intermediate the top and bottom thereof, and internal water passages? A. They became popular about 1926, and from then on practically all of them have been made that way."

To the same effect is the testimony of Philip Arthur Tanner, Vice President of respondent, Outboard, Marine and Manufacturing Company, testifying with respect to outboard motors manufactured by the Lockwood Ash Motor Company in 1926, when he was associated with that company (R. 225):

"Q. What did your motor lack particularly of the structure shown in this Johnson patent? A. We did not have an anti-cavitation plate."

Q. What did you do to remedy this difficulty? A. In the fall of 1926, for the 1927 model year, we put on an anti-cavitation plate."

Q. Did that remedy your difficulty, so far as cavitation was concerned? A. Yes."

Q. Do you know what was done by Evinrude and Elto? A. My recollection is that possibly, not at the same moment, I doubt Evinrude did the same year, put on an anti-cavitation plate on the stream line housing. I don't remember clearly whether Elto did it that year or the next, but they subsequently did put on the same combination."

Therefore, it will be seen that the subject matter of, and alleged invention defined by the four claims of the Johnson

patent had been publicly and commercially adopted for more than two years prior to their assertion or injection into the Johnson application for patent.

In consequence, the Johnson patent is an outstanding example of a patent applicant for *one* invention, modifying and changing his statement of invention years after his application was filed, for the apparent purpose of appropriating and claiming what had been developed or commercially adopted in the interim. This Court has frequently and emphatically stated that this may not legally be done. *Schriber-Schroth v. Cleveland Trust Co.*, 305 U. S. 47, 57; *Mackay Radio & Telegraph Co. v. Radio Corporation of America*, 306 U. S. 86, 101; *Chicago & N. W. R. Co. v. Sayles*, 97 U. S. 554, 563; *Powers-Kennedy Contracting Corp. v. Concrete Mixing & Conveying Co.*, 282 U. S. 175, 185.

As this Court tersely put it in the *Chicago & N. W. R. Co.* case, *supra*,

“Courts should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration, or to appropriate that which has, in the meantime, gone into public use.”

Again, this Court said in the *Schriber-Schroth* case, *supra*,

“ . . . the application for a patent cannot be broadened by amendment so as to embrace an invention not described in the application as filed, at least when adverse rights of the public have intervened.”

It is submitted, therefore, that claims 11, 12, 13 and 14 of the Johnson patent are invalid for the reason stated.

POINT II.

The four claims of the Johnson patent are invalid because they merely catalog unpatentable aggregations.

A mere reading of each of the four claims of the patent makes it evident that they merely catalog the elements necessary to make an outboard motor assembly, regardless of whether or not there is any cooperative relation—much less, *patentable* coordination—between them.

Referring to claim 11, for example, as has already been pointed out (*ante*, pp. 10, 11), this claim catalogs ten usual elements of an outboard motor assembly, each of which, concededly, was old in the art, and each of which performs its own independent function regardless of whether or not it is utilized in the combination recited by the claim, or in some other combination. For example, what patentable cooperation (as distinguished from unpatentable aggregation) could possibly exist between a propeller shaft casing having an anti-cavitation plate extending rearwardly and overlying the propeller blades (element 8 in the analysis of the claim, *ante*, p. 11), and a substantially vertical water cooling conduit leading to the water jacket of the engine (element 9 of the analysis)? Or, as another illustration, what patentable coordination could possibly exist between a stationary support carrying a bearing (element 1 in the analysis), with a propeller shaft casing; or an anti-cavitation plate; or a vertically extending internal water passage? In like fashion, practically all of the other elements of the outboard motor assembly catalogued in the claim will be seen to be wholly devoid of patentable coordination with the other elements.

What has been said with respect to claim 11 is emphasized by claim 12, because, in addition, it brings into the combination a description of the propeller shaft housing as "having unbroken outer wall surfaces at each side extending upwardly" therefrom to the cavitation plate, "and from said plate upwardly a substantial distance to the top of the housing". It is believed to be self-evident that no patentable coordination could possibly exist between this element and the other elements of the claim to which reference has already been made.

Again, with respect to claim 13, it is quite apparent that there is and can be no patentable coordination between an anti-cavitation plate *cast integral with the propeller shaft housing*, on the one hand (element 3 of the analysis of the claim, *ante*, p. 12), and a vertically extending turnable propeller shaft casing provided with an internal water passage opening below the normal water level (element 1 of the analysis).

The same is true with respect to claim 14, and this is further emphasized by the fact that the anti-cavitation plate is there described as being positioned "substantially midway of the height of the propeller shaft casing"—a feature having no coordination whatever with the remaining elements of the claim.

It is believed, therefore, that the fatally aggregational character of all four of the claims is so apparent that further argument on the merits of the point is unwarranted.

Likewise, in view of the recent decisions of this Court on the subject of unpatentable aggregation, an argument on the law of the subject would be presumptuous (*Powers-Kennedy Contracting Corp. v. Concrete Mixing and Conveying Co.*, 282 U. S. 175, 186; *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 549).

Regarded either from the viewpoint that all Johnson has done is to combine "old elements or devices accomplishing no more than an aggregate of old results" (*Powers-Kennedy* case, *supra*), or that he has improved one part of an old combination (casting the anti-cavitation plate integrally with the propeller casing) and has attempted "to claim that improvement in combination with other old parts which perform no new function in the combination" (*Lincoln Engineering* case, *supra*), the claims of the patent are invalid.

POINT III.

The Johnson patent is invalid because of anticipation by or want of invention over the prior art.

In discussing the questions of anticipation and want of invention, it makes no difference whether the alleged invention of Johnson is considered to be what the Court of Appeals below found it to be, or what the claims define it to be. In both instances there is complete anticipation by the prior art, and want of invention by Johnson thereover.

In so far as is concerned the first definition of the Court of Appeals, namely, the provisions of means "to avoid what in this art is known as cavitation" (R. 620), it is evident from what has already been said, that no novelty—much less *invention*—can be accorded Johnson. In the first place, there is the flat concession by Johnson in the file history of his application for patent that " . . . it is conceded that cavitation plates are old in the art as shown in the patent of Johnson cited" (Appendix, 19). In the next place, the prior patent to Johnson (R. 482), referred to in this concession, clearly shows the anti-cavitation plate 47, which

is described in the specification (R. 489, line 9) as being horizontally disposed to "prevent cavitation". Additionally, attention is directed to the Smith patent of 1917 (R. 418), wherein the anti-cavitation plate is designated by the reference numeral 12, and is described (R. 419, lines 11 *et seq.*) as being provided so as to prevent the propeller from "taking air". Obviously, therefore, and contrary to the viewpoint of the Court of Appeals below, there is complete and literal anticipation by the prior art of what that Court considered to be Johnson's contribution.

Similarly, with respect to the opinion of the Court of Appeals that the invention of Johnson resides in the "co-operative relationship between the anti-cavitation plate and streamlining of a portion of the outboard motor structure" (R. 621), it would seem to be self-evident that no *patentable* concept, or *invention* could be predicated upon combining those two ideas, which, at best, was a mere matter of design, requiring nothing more than the expected skill of the art.

However, the invention defined by the four claims of the Johnson patent is not for either of these two things on which the opinion of the Court of Appeals was based. To the contrary, the anti-cavitation plate is recited in the claims, concededly, as merely an old element possessing no novelty whatever; and the alleged "streamlining" is referred to in only two of the claims (claims 12 and 14), and then merely as "unbroken outer wall surfaces" and "smooth and unbroken walls" respectively—language which finds complete response in each of the prior art references to which attention has already been directed, and, as a matter of convenience, is here repeated (R. 360, 376, 394, 494, 502, 526, 532, 591). Particular attention is directed

to the Pierce patent (R. 526) which shows a stream-lined casing (1), in the extreme sense of the term, and in which is located the water conduits (16, 18) for the circulatory system for water-cooling the engine. This Pierce patent is of particular significance when it is noted that it issued on April 6, 1926—*nearly three years prior to the amendment (on March 30, 1929) of the Johnson application* which sought to appropriate the invention of the Pierce patent by aggregationally combining it with the other usual, conventional parts of an outboard motor assembly.

In the final analysis the *only* element of novelty that can be asserted for the Johnson claims is the idea of *casting the old anti-cavitation plate integrally with the old casing for the propeller shaft*; and this feature is mentioned only in claims 13 and 14. It is believed to be too obvious to warrant argument that no patentable invention, even when properly claimed, can be based on casting any two parts of a metal structure in one piece, whenever and wherever desired. Indeed, this, in effect, was testified to by respondents' witness Irgens (R. 70) when he was asked how he would mount or fasten an anti-cavitation plate on the streamlined propeller housing of the prior Pierce patent (R. 526), and he answered:

"On a housing of that type, that is a sand casting, and the easiest way would be to cast it on to the housing."

Q. As an integral part? A. Yes."

It follows, therefore, that claims 11, 12, 13 and 14 of the Johnson patent are invalid for anticipation by or want of invention over the prior art.

Conclusion.

The judgment of the Seventh Circuit Court of Appeals should be reversed, and the cause remanded to the District Court for the Northern District of Illinois, Eastern Division, with instructions to dismiss the complaint, with judgment against respondents for petitioners' costs sustained in the cause.

Respectfully submitted,

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